

**AMENDMENTS TO THE DRAWINGS**

Ten amended drawing figures are attached following page 27 of this paper. The amended drawing figures are numbered 3-11. The Applicant has corrected the hand-written numbering on the originally submitted drawings. The ten replacement sheets are being submitted as formal drawings. The Applicant points out that no new matter has been introduced by the amendments to Figures 3-11.

### **REMARKS / ARGUMENTS**

The present application includes pending claims 1-25, all of which have been rejected. By this Amendment, claims 1-25 have been amended, as set forth above, to further clarify the language used in these claims and to further prosecution of the present application. The Applicant respectfully submits that the claims define patentable subject matter.

Initially, the Applicant notes that a goal of patent examination is to provide a prompt and complete examination of a patent application.

It is essential that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the *initial review* of the application, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, Office personnel *should* state *all* reasons and bases for rejecting claims in the *first* Office action. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, Office personnel should indicate how rejections may be overcome and how problems may be resolved. A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.

See Manual of Patent Examining Procedure (MPEP) § 2106(II). As such, the Applicant assumes, based on the goals of patent examination noted above, that the present Office Action has set forth "all reasons and bases" for rejecting the claims.

The Specification was objected to because of informality. The Applicant has amended claims 9, 16, and 25, as set forth above, to overcome the informality.

Claims 1-4, 6, 7, 9, 16-20, and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0059621, issued to Thomas, et al. (hereinafter, Thomas), in view of U.S. Patent No. 7,134,131, issued to Hendricks, et al. (hereinafter, Hendricks). Claims 5 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Thomas, in view of Hendrick and U.S. Patent Application Publication No. 2004/0235521, issued to Pradhan, et al. (hereinafter, Pradhan). Claims 10-15 and 21-24 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Thomas. The Applicant respectfully traverses these rejections at least for the reasons previously set forth during prosecution and at least based on the following remarks.

#### **REJECTION UNDER 35 U.S.C. § 103**

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure ("MPEP") states the following:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the teaching. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The

teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

See MPEP at § 2142, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added). Further, MPEP § 2143.01 states that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination," and that "although a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a *suggestion or motivation in the reference* to do so'" (citing *In re Mills*, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990)). Moreover, MPEP § 2143.01 also states that the level of ordinary skill in the art cannot be relied upon to provide the suggestion..., "citing *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ 2d 1161 (Fed. Cir. 1999). Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

**I. The Proposed Combination of Thomas and Hendricks Does Not Render Claims 1-4, 6, 7, 9, 16-20, and 25 Unpatentable**

The Applicant now turns to the rejection of claims 1-4, 6, 7, 9, 16-20, and 25 as being unpatentable over Thomas in view of Hendricks.

**A. Independent Claims 1 and 17**

With regard to the rejection of independent claim 1 under 103(a), the Applicant submits that the combination of Thomas and Hendricks does not disclose or suggest at least the limitation of “a card carrying information related to one or more user-defined selections of the information content, wherein the card allows the at least one communication device to access the user-defined selections identified by the card, once the card is communicatively coupled to the at least one communication device,” as recited by the Applicant in independent claim 1.

The Office Action states the following:

Regarding to claim 1: ... Thomas fails to disclose a card carrying information related to one or more user-defined selections of the information content; wherein the card allows the at least one communication device to access the user-defined selections.

**Hendricks discloses a card (smart card 180) carrying information related to one or more user-defined selections (col.10.lines 10-15)** of the information content (programming 115), wherein the card allows the at least one communication device (TV 171) to access the user-defined selections (Fig. 4b, 4c, col. 8, lines 19-36 and Fig. 8 col. 19 lines 23-58). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify a smart card as interface device as taught by

Hendricks in Thomas's system; in order to access the user's defined content in media exchange network.

See the Office Action at pages 3-4 (emphasis added). The Examiner has conceded that Thomas fails to disclose a card carrying information related to one or more user-defined selections of the information content; wherein the card allows the at least one communication device to access the user-defined selections, as recited in Applicant's claim 1. The Examiner then relies for support on the following citation of Hendricks:

The video signals and program control signals received by the set top terminal 220 correspond to specific television programs and menu data that each subscriber may access through a subscriber interface. The subscriber interface is a device with buttons, such as a key pad, located on the set top terminal 220 or the portable remote control 900.

See Hendricks at col. 10, lines 10-15. At the above citation, Hendricks simply discloses that the set top terminal 220 may receive video signals and program control signals that may be accessed via a keypad on the set top terminal 220 or the remote control 900. **Hendricks, including the above citation, does not disclose or suggest that information regarding a user-defined selection of information content is carried on a card.** In reference to the smart card 180 (FIGS. 4b, 4c, 10, and 14), Hendricks discloses that the smart card may include a cable modem, a telephone modem, a wireless modem, a fiber optic connector, or

a LAN connector. In other words, the smart card 180 carries out interface/communication functionalities for the set top box 220. See Hendricks at col. 8, lines 26-36. Hendricks also discloses that the smart card 180 may be used to order programming via conventional methods. More specifically, Hendricks discloses that the card 180 can be used for ordering program content by selecting a specific program on the program guide, and then ordering it via the remote control 900. See *id.* at col. 18, lines 18-60, and col. 23, line 62 – col. 24, line 4, and col. 28, lines 1-11. In this regard, Hendricks, including col. 10, lines 10-15, does not disclose that the card carries user defined selections, where the card allows access to the user-defined selection identified by the card.

Therefore, the Applicant maintains that the combination of Thomas and Hendricks does not disclose or suggest at least the limitation of “a card carrying information related to one or more user-defined selections of the information content, wherein the card allows the at least one communication device to access the user-defined selections identified by the card, once the card is communicatively coupled to the at least one communication device,” as recited by the Applicant in independent claim 1.

Accordingly, the proposed combination of Thomas and Hendricks does not render independent claim 1 unpatentable, and a *prima facie* case of obviousness has not been established. The Applicant submits that claim 1 is allowable. Independent claim 17 is similar in many respects to the method disclosed in

independent claim 1. Therefore, the Applicant submits that independent claim 17 is also allowable over the references cited in the Office Action at least for the reasons stated above with regard to claim 1.

**B. Rejection of Dependent Claims 2-4, 6, 7, 9, 16, 18-20, and 25**

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1 and 17 under 35 U.S.C. § 103(a) as being unpatentable over Thomas in view of Hendricks has been overcome and requests that the rejection be withdrawn. Furthermore, independent claims 10 and 21 are similar in many respect to the method disclosed in independent claim 1, and therefore are allowable over the references cited in the Office Action at least for the reasons stated above with regard to claim 1. Additionally, claims 2-4, 6, 7, 9, 16, 18-20, and 25 depend from independent claims 1, 10, 17, and 21, respectively, and are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 2-4, 6, 7, 9, 16, 18-20, and 25 .



**II. The Proposed Combination of Thomas, Hendricks and Pradhan Does Not Render Claims 5 and 8 Unpatentable**

Claims 5 and 8 depend from independent claim 1, and are, consequently, also respectfully submitted to be allowable at least for the reasons stated above with regard to allowability of claim 1. The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 5 and 8.

**REJECTION UNDER 35 U.S.C. § 102**

**III. Thomas Does Not Anticipate Claims 10-15 and 21-24**

The Applicant now turns to the rejection of claims 10-15 and 21-24 under 35 U.S.C. 102(e) as being anticipated by Thomas. With regard to the anticipation rejections under 102(e), MPEP 2131 states that “[a] claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” See Manual of Patent Examining Procedure (MPEP) at 2131 (internal citation omitted). Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” See *id.* (internal citation omitted).

**A. Rejection of Independent Claim 10 under 35 U.S.C. § 102(e)**

With regard to the rejection of independent claim 10 under 102(e), the Applicant submits that Thomas does not disclose or suggest at least the limitation of "the independent server **receives one or more user-defined selections of the information content** and **provides media exchange services related to the one or more user-defined selections of the information content to the first communication device and the second communication device**, upon receipt of authentication and billing information for the one or more user-defined selections from the first communication device," as recited by the Applicant in independent claim 10.

The Office Action states:

Regarding to claim 10: Thomas discloses ...

wherein the independent server (210) is adapted to provide media exchange services related to user-defined selections of information content (para. [0061]) to the first communication device (264) and the second communication device (269), upon receipt of authentication (log in 315 and log out 316 on remote control 300, Fig. 3, para. 0063] and para.[ 0080,0081]) and billing information (Billing INFO button on remote control 300, see Fig. 3 para. [0067]) from the first communication device (remote control 300 to communication device 264) (see Fig. 2 and 3).

See Office Action at pages 12-13. Paragraph 0061 of Thomas discloses that the user equipment platform provides accessing, manipulating, and storing of data. However, ¶ 0061 does not disclose any services with regard to a user-defined selection of information content. The Examiner further refers to the login

and logout buttons on the remote control 300 of FIG. 3 of Thomas. Referring to FIG. 3 of Thomas, the Applicant points out that the login and logout buttons (315 and 316), as well as the other function buttons described in ¶ 0063, relate to functionality of a single remote control, which may be used only for a specific user equipment (e.g., input devices 261 or 266 in FIG. 2, used for set-top boxes 263 or 268, respectively). In this regard, **the remote control 300 does not provide media exchange services related to user-defined selections of information content to a first communication device and a second communication device**, as recited in Applicant's claim 10.

Accordingly, independent claim 10 is not anticipated by Thomas and is allowable. Independent claim 21 is similar in many respects to the method disclosed in independent claim 10. Therefore, the Applicant submits that independent claim 21 is also allowable over the references cited in the Office Action at least for the reasons stated above with regard to claim 10.

#### **B. Rejection of Dependent Claims 11-15 and 22-24**

Based on at least the foregoing, the Applicant believes the rejection of independent claims 10 and 21 under 35 U.S.C. § 102(b) as being anticipated by Thomas has been overcome and requests that the rejection be withdrawn. Additionally, claims 11-15 and 22-24 depend from independent claims 10 and 21, respectively, and are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 11-15 and 22-24.

**CONCLUSION**

Based on at least the foregoing, the Applicant believes that all claims 1-25 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and requests that the Examiner telephone the undersigned Attorney at (312) 775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

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